

ESTTA Tracking number: **ESTTA535326**

Filing date: **04/30/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	ZS Associates, Inc.
Granted to Date of previous extension	05/01/2013
Address	1800 Sherman Avenue Evanston, IL 60201 UNITED STATES
Attorney information	Christine B. Redfield K&L Gates LLP 925 4th Ave. Ste. 2900 Seattle, WA 98104-1158 UNITED STATES pltrademarks@klgates.com, christine.redfield@klgates.com Phone:650-798-6705

Applicant Information

Application No	85205380	Publication date	01/01/2013
Opposition Filing Date	04/30/2013	Opposition Period Ends	05/01/2013
Applicant	Javelin Corporate Development Partners Inc. 25 King Street West, Suite 2900 Toronto, Ontario, M5L1G3 CANADA		

Goods/Services Affected by Opposition

Class 035. All goods and services in the class are opposed, namely: Providing corporate business development and general business management consulting services to private and public companies in the mining, metals, natural resources and agriculture industries; providing investor relations services, namely, business consulting services in the field of investor relations to private and public companies in the mining, metals, natural resources and agriculture industries
Class 036. All goods and services in the class are opposed, namely: Providing investor relations services, namely, financial consulting services in the field of investor relations to private and public companies in the mining, metals, natural resources and agriculture industries

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3818900	Application Date	03/12/2008
Registration Date	07/13/2010	Foreign Priority Date	NONE
Word Mark	JAVELIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2008/04/28 First Use In Commerce: 2008/04/28 Computer software for management consulting, sales and marketing consulting, capability building and outsourcing		

Attachments	Opposition.PDF (10 pages)(507707 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Christine B. Redfield/
Name	Christine B. Redfield
Date	04/30/2013

In re Trademark Serial No.: 85/205,380
Published in the Official Gazette on January 1, 2013
Mark: JAVELIN PARTNERS & Design



Applicant.

PL-79403 v3

2. As illustrated in Application Serial No. 85/205,380, Applicant seeks to register its

JAVELIN PARTNERS & Design mark in connection with the following services:

“Providing corporate business development and general business management consulting services to private and public companies in the mining, metals, natural resources and agriculture industries; providing investor relations services, namely, business consulting services in the field of investor relations to private and public companies in the mining, metals, natural resources and agriculture industries” in International Class 35; and

“Providing investor relations services, namely, financial consulting services in the field of investor relations to private and public companies in the mining, metals, natural resources and agriculture industries,” in International Class 36.

3. Applicant filed its application to register the JAVELIN PARTNERS & Design mark on December 23, 2010, based on Section 1(b) of the Trademark Act.

4. Since at least 1983, Opposer has provided management consulting services. Over the years, Opposer has built a large and successful international business and reputation as a global management consulting firm specializing in sales and marketing consulting, capability building, and outsourcing. Opposer is currently one of the world’s largest business service firms, and a market leader in the provision of sales and marketing consulting services.

5. Since at least as early as April 28, 2008, Opposer has used and continues to use its JAVELIN® trademark in connection with a suite of software programs. The “Javelin” software is a market-leading SaaS platform that allows marketing executives to manage and implement strategies for sales incentives, call planning, promotions, forecasting, outsourcing and account management. The JAVELIN® trademark is arbitrary as applied to the goods and services provided by Opposer under the trademark and is therefore clearly inherently distinctive.

6. Opposer has prominently and extensively used, promoted, and advertised its products bearing the JAVELIN® trademark. Opposer has expended considerable money and effort in promoting and advertising its goods under the JAVELIN® trademark to reach current and prospective customers, including via its website located at www.zsassociates.com.

7. No issue of priority exists with respect to Opposer's first use date of its registered JAVELIN® trademark and the Applicant's JAVELIN PARTNERS & Design mark application. Opposer's JAVELIN® trademark has been in continuous use in commerce since at least as early as April 28, 2008, well before the December 23, 2010 filing date of applicant's intent to use application for the JAVELIN PARTNERS & Design mark. The JAVELIN® registration issued on July 13, 2010 under U.S. registration no. 3,818,900 for "computer software for management consulting, sales and marketing consulting, capability building and outsourcing," in International Class 9, and is now incontestable. A true and correct copy of Opposer's registration certificate is attached hereto as Exhibit A.

8. Today, Opposer's JAVELIN® trademark is highly recognized by the general consuming public of the United States. The JAVELIN® trademark is a valuable mark within the SaaS industry, particularly in connection with software programs for use in connection with business and management consulting services. As a result of Opposer's use and promotion of its goods and services under or by reference to the JAVELIN® trademark, consumers have come to recognize the JAVELIN® trademark as a symbol of the goodwill inherent in the products and services bearing the JAVELIN® trademark, and further, to solely associate the JAVELIN® trademark with the Opposer and its high quality goods and services.

9. Applicant's proposed mark is clearly confusingly similar to the JAVELIN® trademark because it is similar in appearance, meaning, and overall impression pursuant to 15 U.S.C. § 1052(d).

10. Firstly, Applicant's JAVELIN PARTNERS & Design mark contains the identical element "JAVELIN" within the mark. As this term is entirely arbitrary when applied to the services sought to be covered by the Applicant, it is clear that it is intended to be the most distinctive element of the trademark. Given the element's distinctiveness in the context of both the JAVELIN PARTNERS & Design mark and the JAVELIN® trademark, it is clear that this overlap creates a high likelihood of confusion between the marks.

11. Further, if one considers the depiction of the JAVELIN PARTNERS & Design mark provided in the specimen to Applicant's trademark application, it is clear that the silhouette of a person's head and extended arm holding an arrow, is intended to be viewed as one element and the words "JAVELIN PARTERS" are to be read together as a separate second element. If a mark comprises both wording and a design, then greater weight is to be accorded to the wording because it is the wording that purchasers would use to refer to or request the goods or services. (Trademark Manual of Examining Procedure at 1207.01(c)(ii)). The design element in the proposed trademark therefore adds little to considerations of confusing similarity between the JAVELIN PARTNERS & Design mark and the JAVELIN® trademark. Further, if anything, its presence serves merely to highlight the fact that the dominant portion of the mark is intended to be "JAVELIN PARTNERS."

12. If one then considers the dominant portion of both marks, it is clear that there is a high degree of confusing visual and phonetic similarity between "JAVELIN PARTNERS" and

"JAVELIN," rendering the JAVELIN PARTNERS & Design mark as a whole confusingly similar to the JAVELIN® trademark.

13. In addition, the Applicant states that it intends to use JAVELIN PARTNERS & Design mark in connection with "Providing corporate business development and general business management consulting services to private and public companies in the mining, metals, natural resources and agriculture industries; providing investor relations services, namely, business consulting services in the field of investor relations to private and public companies in the mining, metals, natural resources and agriculture industries" in International Class 35. There is a clear overlap between the "corporate business development and general business management consulting services...[and]...business consulting services in the field of investor relations" that Applicant proposes to provide under its JAVELIN PARTNERS & Design mark and the incontestable rights Opposer enjoys in providing "management consulting, sales and marketing consulting, capability building and outsourcing" software under or by reference to its JAVELIN® trademark. Further, as a result of Opposer's long history of continuous use of the JAVELIN® trademark in connection with its business and management consulting services software programs, consumers are likely to believe that Applicant's JAVELIN PARTNERS & Design mark is associated with the goods and services provided by the Opposer in connection with its JAVELIN® trademark.

14. Thirdly, due to the considerable overlaps in trade channels that are, or will be, used by both the Applicant and the Opposer, prospective purchasers and others are likely to be confused as to whether Applicant's goods and services sold under the JAVELIN PARTNERS & Design mark emanate from and/or are in some way affiliated with, or sponsored or approved by

Opposer, or are otherwise related to the Opposer and/or to Opposer's goods and services, thereby damaging Opposer.

15. Finally, given the overwhelming goodwill and public recognition arising from the association of the JAVELIN® trademark with the Opposer, consumers are likely to believe that the Opposer has licensed, approved, or otherwise authorized Applicant's use of the JAVELIN PARTNERS & Design mark, when it in fact has not.

16. The maturation of Applicant's application into registration will cause a likelihood of confusion, mistake, or deception with respect to the source or origin of Applicant's goods. There is a strong likelihood that consumers will erroneously believe that Applicant's goods are licensed by or associated with the Opposer.

17. Pursuant to 15 U.S.C. § 1063(a), Opposer will clearly be damaged by registration of Applicant's proposed mark, which would grant Applicant a *prima facie* exclusive right to use the proposed mark, despite Opposer's priority over Applicant and the likelihood of confusion, dilution, and injury to Opposer's goodwill that will be caused by Applicant's mark.

18. In summary, registration of the JAVELIN PARTNERS & Design mark would be incorrect and improper in view of the requirements of the Trademark Act of 1946, as amended, including specifically but not limited to the provisions of 15 U.S.C. §§ 1051 *et seq.*

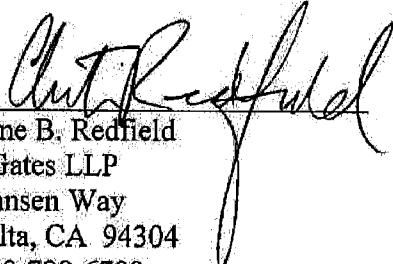
WHEREFORE, Opposer respectfully requests that this Opposition be sustained, and that registration to Applicant for JAVELIN PARTNERS & Design in Application Serial No. 85/205,380 of the services identified in International Classes 35 and 36 be denied.

Opposer submits this Notice of Opposition via the e-filing procedure of the Trademark Trial and Appeal Board, and hereby authorizes the Board to debit Deposit Account No. 503229 of K&L Gates LLP for the appropriate filing fee of \$600.00. Please direct all notices, pleadings, correspondence, and other papers in this matter to the undersigned counsel for the Opposer.

Respectfully submitted,

K&L GATES LLP

Dated: April 30, 2013

By 
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Notice of Opposition has been properly served via U.S. mail on the following correspondent for Applicant on this 30th day of April, 2013.

Andrea L. Calvaruso
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New York, NY 10178-0002



Alice Schermer

EXHIBIT A

United States of America

United States Patent and Trademark Office

JAVELIN

Reg. No. 3,818,900

Registered July 13, 2010

Int. CL: 9

TRADEMARK

PRINCIPAL REGISTER

ZS ASSOCIATES, INC. (ILLINOIS CORPORATION)
1800 SHERMAN AVENUE
EVANSTON, IL 60201

FOR: COMPUTER SOFTWARE FOR MANAGEMENT CONSULTING, SALES AND MARKETING CONSULTING, CAPABILITY BUILDING AND OUTSOURCING, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 4-28-2008; IN COMMERCE 4-28-2008.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 77-419,919, FILED 3-12-2008.

KYLE PEETE, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office